

Attorney Docket No. 09792909-4879

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:

Yoji Kawamoto, et al.

Application No. 09/593,107

Filed: June 13, 2000

For: "Communication System, Network
System, Information Controller and
Terminal Equipment"

) Group Art Unit: 2144
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) Examiner: Thanh T. Nguyen
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TRANSMITTAL OF APPELLANTS' APPEAL BRIEF

Enclosed in triplicate is Appellants' Appeal Brief for the above-referenced United States Patent Application. Appellants believe that the Brief is in full compliance with 37 C.F.R. §1.192(c). The fee for filing this Brief is \$500.00.

This brief is hereby submitted within six months of the date of the Notice of Appeal was received in the United States Patent and Trademark Office. Applicant hereby petitions for a two-month extension of time. The fee to cover this extension fee is \$450.00. The Commissioner is hereby authorized to charge the filing fee and the extension fee to applicants' attorneys' American Express account. Form 2038 is attached for that purpose. The Commissioner also is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 19-3140. A duplicate copy of this sheet is enclosed.

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I. Real Party in Interest

The real party in interest in this application is Sony Corporation.

II. Related Appeals and Interferences

Applicant is unaware of any related prior or pending appeals, interferences, or judicial proceedings which may be related to, directly affect or be directly affected by or have any bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-15 are pending and stand rejected in this application. Applicant seeks review of the Examiner's rejection of claims 1-15 in this appeal.

IV. Status of Amendments

In an office action mailed October 7, 2003, original claims 1-15 were rejected as anticipated by U.S. Patent No. 6,049,787 to Takahashi ("Takahashi"). Claims 1-15 were amended in a response, but were then rejected in a final office action mailed on May 18, 2004 -- again as anticipated by Takahashi. Claims 1, 3, 5, 10, and 13 were amended in response to the Final Office Action. However, the amendments were not entered in response to the Final Office Action.

On September 3, 2004, Applicants filed a Request for Continued Examination with the amendments (to claims 1, 3, 5, 10, and 13) submitted in response to the May 18, 2004 Final Office Action. The Examiner entered the amendments to claims 1, 3, 5, 10, and 13 and rejected claims 1-15 as anticipated by Takahashi in an office action mailed on October 6, 2004.

V. Reservation Of Right To Supplement Appeal Brief

Applicants respectfully reserve the right to supplement this brief in response to any issued office action.

VI. Summary of Claimed Subject Matter

The present invention relates to a communication system, an information controller, a network system, and a variety of terminal equipment for use by one or more users.¹ The network system may include a domestic network system, a company network system, and any other public or private communications network that provides users with resources for communicating information. *See e.g.* Specification ("Spec."), Fig. 1; and FIGURE A below. The terminal equipment may be, for example, a computer 35 and 53, a printer 36 and 54, a television 32, an audio reproducing system 34, a video tape recording system 33, a facsimile machine/telephone 37, or any other resource that a user may access, and communicate information with, via a computer network. *See e.g.* Fig. 1; Spec., 6:3-10, 13-19².

¹ It is to be understood that citations herein to the specification shall refer to examples and are not intended to in anyway narrow the scope of any of the claims.

² References to the specification of the present application shall use the following format: "Spec., pg. PAGE#:RANGE OF LINE NUMBERS" or "Spec., pg. PAGE #:LINE - PAGE:LINE" or "Spec., pg. # PAGE RANGE."

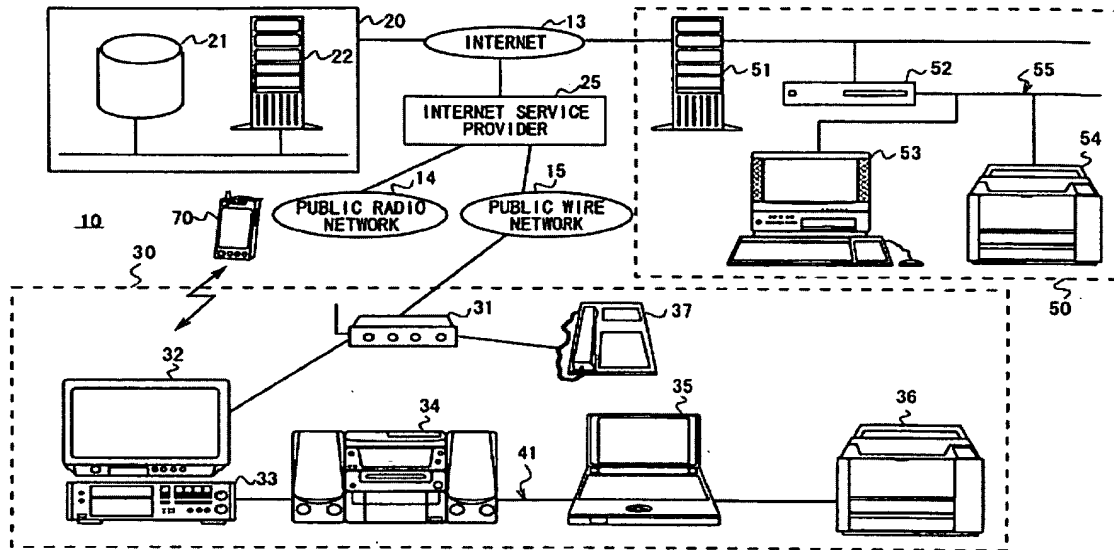


FIGURE A

The terminal equipment may be operably connected to the communication system at domestic network system or at the company network system. Terminal equipment may also connect to the communication system via a public network 14 or 15, or over the Internet 13, or a public telecommunications switching system (*e.g.* a wireless communications network).

Typically, when a user wishes to make use of terminal equipment on his domestic or company network system, the system requires that the user register on a server every time he uses the terminal equipment. This registration requirement becomes inconvenient as it limits maneuverability and requires the user to be conscious of the need to register the terminal equipment he wishes to use. *See Spec., 2.* Embodiments of the present invention allow the user to register automatically, without having to consciously perform a registration step each time he desires to use a terminal equipment.

Independent claim 1 recites a communication system for exchanging prescribed information through a network having pieces of terminal equipment and an information control means. *See e.g.* Spec., Figs. 1, 5, 7, 9, 12, and 18. The network system is configured to effect registration of the pieces of terminal equipment connected to the network system in the information control means. *See e.g.* Spec., 12-14. The registration information comprises information that characterizes the pieces of terminal equipment. For example, the registration information may include information identifying functional characteristics of the pieces of terminal equipment, such as the address, equipment classification, and terminal capacity information (the decode system, the display capacity, etc. of the terminal equipment). *See e.g.* Spec., 12:12-14.

Prescribed information is used to establish a transmission path comprising a receiver and a transmitter, each connected to the network. The information is then communicated to the terminal equipment connected to the receiver from the terminal equipment connected to the transmitter. *See e.g.* Spec., 13:1-14, 9. The transmission path provides the user with access to terminal equipment connected to the receiver. In preferred embodiments, the transmission path may be established automatically, without the user's involvement.

Independent claims 3 and 10 recite an information controller connected to the network and comprising registering means (*e.g.* the server) for registering registered information characterizing terminal equipment connected to the network system. *See e.g.* Spec., 12-14; Figs. 4 & 5. Such terminal equipment includes

terminal equipment of at least one transmitter and terminal equipment of at least one receiver. *See e.g.* Spec., 12-14. The registered information characterizing the pieces of terminal equipment including information identifying functional characteristics of the pieces of terminal equipment. *See* Spec., 12:12-14. The registering information may also characterize terminal equipment used by a user, terminal equipment connected to the terminal equipment used by the user, and other terminal equipment connected to the network. *See e.g.* Spec., Figs. 14 & 15 (Listing examples of types of registering information). The registering information may also identify the user as available environmental information. *Id.*

The information controller also comprises a communication path determining means for determining a transmission path from the terminal equipment of the transmitter to the terminal equipment of the receiver. The path is determined based on the registered information when prescribed information is to be transmitted to the terminal equipment of the receiver from the terminal equipment of the transmitter. *See e.g.* Spec., 13.

Independent claim 5 recites a network system for exchanging prescribed information over a network operatively configured such that registered information is registered in registering means (*e.g.* the server) associated with an information controller -- also connected to the network. *See* Spec., Figs. 1, 5, 7, 9, 12, and 18. The registered information characterizing the pieces of terminal equipment including information identifying functional characteristics of the pieces of terminal equipment. *See* Spec., 12:12-14. The registering information may also characterize

terminal equipment used by a user, terminal equipment connected to the terminal equipment used by the user, and other terminal equipment connected to the network. *See e.g.* Spec., Figs. 14 & 15 (as examples of types of registering information). The registering information may also identify the user as available environmental information. *Id.* The prescribed information is transmitted to terminal equipment specified by the available environmental information.

Independent claim 13 recites terminal equipment connected to the network. The terminal equipment comprises transmitting means for transmitting user identification information for a user using the terminal equipment. The terminal equipment also comprises registered information identifying the terminal equipment, information about connection equipment connecting the terminal equipment to the network as available environmental information, and registered information characterizing the terminal equipment. The registered information includes information identifying functional characteristics of said pieces of terminal equipment. *See e.g.* Spec., 9:20-12, 24; Figs. 14 & 15.

In one example of an embodiment that permits users to register terminal equipment automatically in accordance with embodiments of the present invention, a cellular phone has a local radio communications interface 70T in addition to a public radio communication interface 70E. *See* Fig. 2. The local radio communications interface may be used to communicate with a terminal equipment that has a local wireless communications interface on either the domestic or the company network system. *See* Spec., 9:4-10.

The specification describes an example in which the television has a local communications interface in the domestic network and the personal computer has the local communications interface in the company network. Spec., 12:14. When the user enters the vicinity of the domestic network, the user's cellular phone may communicate a registration request (either upon actuation by the user or automatically by constant broadcast of registration requests). Spec., 12:14. The registration request to the television contains a user ID and a password. Spec., 12:1-2. The registration request is received by the television, and the television would communicate the registration message, along with terminal equipment information about the terminal equipment that is available on the domestic network to the server. Spec., 12:3-12. The terminal equipment information includes address, equipment classification, and terminal capacity information (the decode system, the display capacity, etc. of the terminal equipment). Spec., 12.

The specification describes many other examples of applications that are available to users of exemplary embodiments of the present invention.

VII. Grounds of Rejection to be Reviewed on Appeal

Applicants seek review of the rejection of claims 1-15 as anticipated under 35 U.S.C. § 102(e) by Takahashi. This rejection is the only grounds of rejection relied upon by the Examiner.

VIII. Argument

The Examiner erroneously rejected claims 1-15 as anticipated under 35 U.S.C. § 102(e). Takahashi does not teach any system that uses registering information that

characterizes pieces of terminal equipment, the registering information including information that identifies functional characteristics of the pieces of terminal equipment as recited by each of the independent claims at issue in this appeal.

The rejections in the October 6, 2004 Office Action should be withdrawn and claims 1-15 should be allowed.

A. Takahashi, U.S. Patent No. 6,049,787

Takahashi teaches a system for making electronic business transactions between firms (*i.e.* enterprises, business, etc.) using remote terminals connected to each other by a network. *See* Takahashi 1:60-65³. The types of transactions made on the system are typical business transactions, such as sales, conducted by manufacturers, distributors, shipping agents, buyers, etc. as well as settling functions (*e.g.* by a bank). Takahashi, 4:13-20. Firms conduct transactions at member sites connected to a network, which in turn connects the member sites to a center site. Takahashi, 3:42-53; Fig. 1. The center site connects to other electronic business transactions systems via an external network. *Id. See also* Figure B below.

³ Citations to Takahashi shall have the following format: "Takahashi, COL. #:LINE # RANGE."

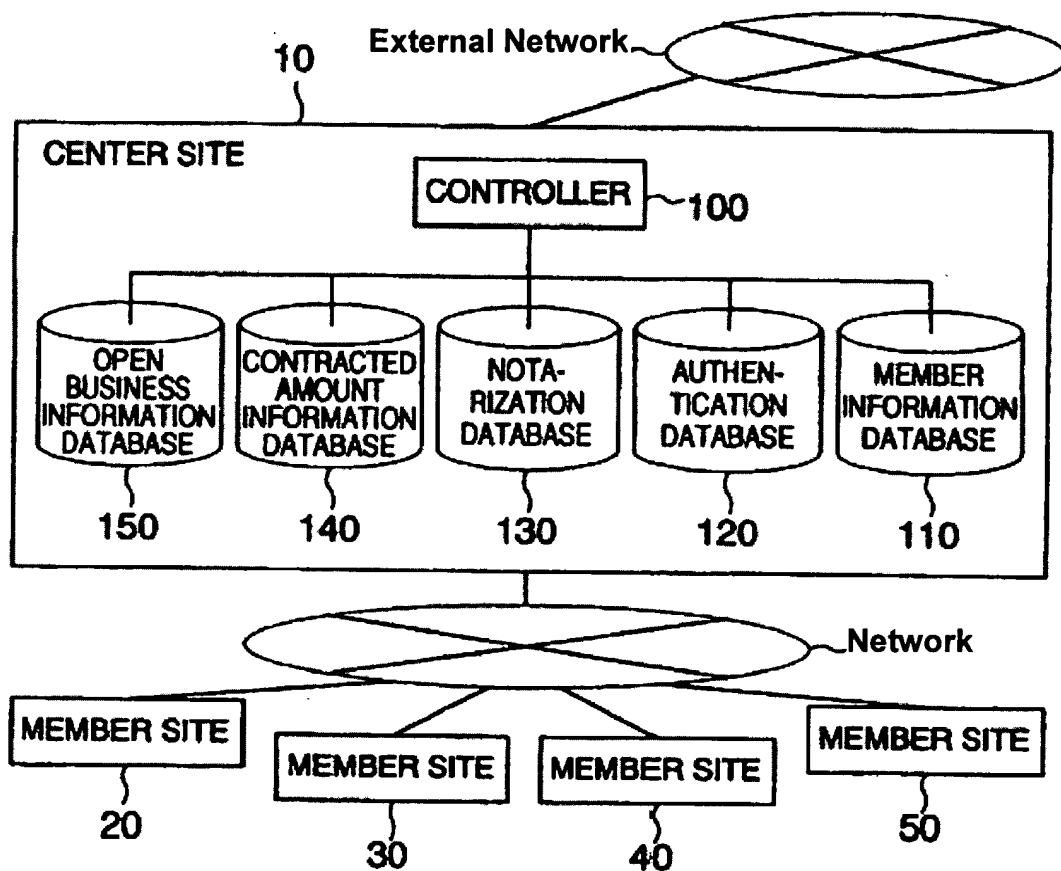


FIGURE B

The center site is situated in the system so as to intervene in the business transactions by the member sites. This intervention provides the business transaction system with authentication of members who conduct transactions, proof of contents and times of transactions, and the names of the members related to the transaction. Takahashi, 1:36-60. The Takahashi system also addresses the perceived need in prior systems of permitting open transactions, such as an open purchase, involving the participation of a large number of firms. *Id.*

During intervention of transactions, the center site uses several databases to process the transaction. The databases include an open business information database, a notarization database, a member information database, an authentication database, and a contract amount information database. Takahashi, 1:60-2:15. The open information database stores open business information received from sites connected to the network that offer articles to buyers in an open business. The notarization database keeps information regarding contracts associated with transactions between member sites on the network. *Id.*

The member information database to control information regarding the member sites of the electronic business transaction system. Takahashi, 3:61-63. Such information includes an identification number, the firm to which the member site belongs, a firm group of the site, the amount of capital, and a type of business of the firm. Takahashi, 4:64-5:3.

The authentication database is used to verify each member site and contains the identification number, a password, and an encryption key. Takahashi, 3:63-64; 5:7-9. The contract amount information database manages information regarding the amount of the contracts between the member sites. 3:66-4:2.

The use of the center site to process business transactions for the member sites are described in Takahashi with reference to flowcharts contained in the drawings. Figure 2 shows a flowchart of operations for registering a new member site. The flowchart shows receipt of a request for a subscription at step 200 in Figure 2, Figure 3 shows the flow of a business transaction; Figure 4 shows the flow of an

open purchase; Figure 4 shows the flow of an open sale; and Figure 11 shows an example of a balance netting operation.

B. Claims 1-15 Are Not Anticipated By Takahashi.

1. Grouping of Claims

Claims 1-2 recite a communication system for exchanging prescribed information through a network having pieces of terminal equipment. Claims 3-4 and 10-12 recite an information controller connected to a network. Claims 5-9 recite a network system and claims 13-15 recite the terminal equipment. Each of independent claims 1, 3, 5, 10, and 13 recite “registered information...characterizing said pieces of terminal equipment including information identifying functional characteristics of said pieces of terminal equipment.” Since Takahashi, *at a minimum*, does not teach “registered information...characterizing said pieces of terminal equipment including information identifying functional characteristics of said pieces of terminal equipment,” independent claims 1, 3, 5, 10, and 13 and each of the claims that are dependent on independent claims 1, 3, 5, 10, and 13 are not anticipated by Takahashi.

2. Takahashi does not teach “registered information
...characterizing said pieces of terminal equipment including
information identifying functional characteristics of said
pieces of terminal equipment.”

In order for Takahashi to anticipate independent claims 1, 3, 5, 10 and 13, it must disclose each and every limitation in the independent claims. *See General Electric Co. v. Nintendo Co., Ltd.*, 179 F.3d 1350, 1356-57 (Fed. Cir. 1999). The October 6, 2004 Office Action rejected Claims 1, 3, 5, 10 and 13 as anticipated by

Takahashi stating that “Takahashi teaches the invention as claimed.” October 6, 2004 Office Action. For each of independent claims 1, 3, 5, 10 and 13, the October 6, 2004 Office Action stated that “(col. 6, lines 14-15 show the registered information, ...), said registered information characterizing said pieces of terminal equipment including information identifying functional characteristics of said pieces of terminal equipment (Fig. 6, col. 4, line 65 to col. 5, line 55, using the information database to store the data information of members)....” *See* October 6, 2004 Office Action, pg. 3-7, ¶¶ 5, 7, 9, 14, and 17.

Takahashi does not teach “registered information characterizing said pieces of terminal equipment” The claims are drawn to systems and apparatuses in which “registered information characterizing said pieces of terminal equipment ...” are registered in an information controller. The registered information is not *any* information, but rather information that would allow a user to operate or otherwise access the terminal equipment. *See Spec.*, 14:10-22. Such information may include the identification of the pieces of terminal equipment available (*i.e.* the identification of each video tape recorder, audio reproducing system, personal computer, printer and facsimile machine available on the network), as well as address, equipment classification and equipment capacity information.

Takahashi teaches a system for making electronic business transactions between firms (*i.e.* enterprises, business, etc.) using remote terminals connected to each other by a network. *See Takahashi*, 1:60-65. Registered information in Takahashi does not relate at all to the terminals connected to the network, but rather to

information required to effect the business transactions enabled by the system. The October 6, 2005 Office Action provides two citations as purportedly teaching “registered information characterizing terminal equipment.” The first is at Takahashi, 6:14-15, which states “[t]he registered information is opened to member sites satisfying the condition of the specified transaction range.” The prior sentences state that the center site “registers the request as open business information to the open business information database 150 (step 404)...Fig. 10 shows structure of the database 150.” Takahashi, 6:13-14. The database 150 shown in Fig. 10 is shown below in FIGURE C.

150

OPEN No.	PURCHASE OR SALE	OPENING SITE	BUSINESS LIMITATION	ITEM No.	QUANTITY	AMOUNT	DATE OF DELIVERY	COMPLETED	CONTRACT No.
0001	PURCHASE	ABC	SAME GROUP	X 003	100	10,000	97 10 15	COMPLETED	0003
0002	SALE	XYZ	WITHOUT LIMITATION	Z 033	-	UNIT PRICE 3,000	-		

FIGURE C

The information described by Takahashi as “registered information” and shown in Fig. 10 contains information characterizing a business transaction and is clearly not information “characterizing terminal equipment.” The items of information -- open no., purchase or sale, opening site, business limitation, item no., quantity, amount, date of delivery, completed and contract no. -- all relate to a business transaction or contract. The information in Fig. 10, however, is consistent with the type of information that would be communicated to meet the objective described in

Takahashi, which is to provide authentication of members who conduct transactions, proof of contents and times of transactions, the names of the members related to the transaction, and to address the perceived need in prior systems of permitting open transactions, such as an open purchase, involving the participation of a large number of firms. Takahashi, 1:36-60.

The October 6, 2004 Office Action also refers to Takahashi, 4:65-5:55 as teaching “registered information.” This second citation, however, also lacks any teaching of “registered information characterizing terminal equipment.” This portion of Takahashi describes the contents of the authentications database and the members information database. *See* Takahashi, 4:65-5:21.

As shown in Fig. 6, the members information database contains an identification number, the firm to which the member site belongs, a firm group of the site, the amount of capital, and a type of business of the firm. Takahashi, 4:64-5:3. None of this information could remotely be said to characterize terminal equipment. Rather, it is used to characterize users and entities relevant to the context of electronic business transactions, which is the field of the invention described in Takahashi. *See* Takahashi 1:8-14. Accordingly, the members information database does not disclose or suggest “registered information characterizing terminal equipment.”

As shown in Fig. 7, the authentication database contains the identification number, a password, and an encryption key. *See* Takahashi, 5:7-21. Again, none of this information could remotely be said to characterize terminal equipment. The information in the authentication database relates to information used by users and

entities involved in electronic business transactions. Accordingly, the authentication database does not disclose or suggest “registered information characterizing terminal equipment.”

The remaining portion of the passage cited by the Examiner in Takahashi describes operation of the flowchart in Fig. 3. There Takahashi states:

Fig. 3 is a flowchart showing an example of the job flow of achieving business transactions between two member sites. In the example, it is assumed that a member site 20 purchases articles or items from a member site 30.

Takashi, 5:22-25. The remainder of the passage to line 55 describes an electronic purchase of articles as an example of an electronic business transaction. Takahashi, 5:26-55. The passage does not mention “registered information characterizing terminal equipment” or anything that would suggest that Takahashi uses any type of information that would characterize a terminal equipment.

Takahashi clearly fails to teach or disclose “registered information characterizing terminal equipment,” which is a limitation in each of independent claims 1, 3, 5, 10 and 13. Therefore, Takahashi fails to anticipate any pending independent claim and by extension any dependent claim as well.

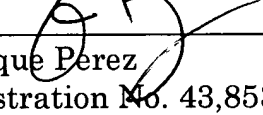
IX. Conclusion

In view of the above, Applicants respectfully submit that claims 1-15 are allowable.

Respectfully submitted,

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APPENDIX

1. (Previously Presented) A communication system for exchanging prescribed information through a network having pieces of terminal equipment and an information control means connected thereto, said communication system being operatively configured such that:

registered information characterizing said pieces of terminal equipment connected to said network system is registered in said information control means connected to said network system, said registered information characterizing said pieces of terminal equipment including information identifying functional characteristics of said pieces of terminal equipment, and

when prescribed information is transmitted to the terminal equipment of a receiver connected to said network from the terminal equipment of a transmitter connected to said network, a transmission path for transmitting said information from said terminal equipment of the transmitter to said terminal equipment of the receiver is established on the basis of said registered information.

2. (Previously Presented) The communication system according to Claim 1, wherein said prescribed information transmitted from said terminal equipment of said transmitter is converted into information which can be received by said terminal equipment of said receiver.

3. (Previously Presented) An information controller connected to a network comprising:

registering means for registering registered information characterizing terminal equipment connected to said network system including terminal equipment of at least one transmitter and terminal equipment of at least one receiver, said registered information characterizing said pieces of terminal

equipment including information identifying functional characteristics of said pieces of terminal equipment; and

communication path determining means for determining a transmission path from said terminal equipment of said transmitter to said terminal equipment of said receiver based on said registered information when prescribed information is to be transmitted to said terminal equipment of the receiver from the terminal equipment of said transmitter.

4. (Previously Presented) The information controller according to Claim 3, further comprising converting means for converting said prescribed information transmitted from said terminal equipment of said transmitter into information capable of being received by said terminal equipment of said receiver.

5. (Previously Presented) A network system for exchanging prescribed information via a network, said networked operatively configured such that:
registered information characterizing terminal equipment used by a user, terminal equipment connected to said terminal equipment used by the user, and other terminal equipment connected to said network, is registered in registering means associated with an information controller also connected to the network, together with information identifying said user, as available environmental information, said registered information characterizing said pieces of terminal equipment including information identifying functional characteristics of said pieces of terminal equipment, and

prescribed information is transmitted to terminal equipment specified by said available environmental information.

6. (Previously Presented) The network system according to Claim 5, wherein terminal equipment having a display capable of displaying at least some of said prescribed information is selected based on the available environmental information registered in said registering means.

7. (Previously Presented) The network system according to Claim 5, wherein said available environmental information includes information identifying an owner of at least one terminal equipment.

8. (Previously Presented) The network system according to Claim 5, wherein said available environmental information is registered in said registering means in accordance with a registration request through said terminal equipment from prescribed portable terminal means.

9. (Previously Presented) The network system according to Claim 5, wherein said available environmental information is registered in said registering means in accordance with a registration request transmitted from said terminal equipment, when prescribed external storing means is connected to said terminal equipment.

10. (Previously Presented) An information controller connected to a network comprising:

registering means for registering information characterizing terminal equipment used by a user, terminal equipment connected to said terminal equipment used by said user, and other terminal equipment connected to said network, together with information identifying said user, as available environmental information, said registered information characterizing said pieces of terminal equipment including information identifying functional characteristics of said pieces of terminal equipment, and

transmitting means for establishing a transmission path such that provided information is transmitted to terminal equipment specified by the registered available environmental information.

11. (Previously Presented) The information controller according to Claim 10, wherein said transmitting means selects terminal equipment having a display

capable of displaying at least some of said provided information on the basis of said registered available environmental information and transmits said provided information to said selected terminal equipment.

12. (Previously Presented) The information controller according to Claim 10, wherein said registering means includes information identifying an owner of terminal equipment.

13. (Previously Presented) Terminal equipment connected to a network comprising:

transmitting means for transmitting user identification information for a user using said terminal equipment, registered information identifying said terminal equipment, information about connection equipment connecting said terminal equipment to said network as available environmental information, and registered information characterizing said terminal equipment including information identifying functional characteristics of said pieces of terminal equipment.

14. (Previously Presented) The terminal equipment according to Claim 13 comprising:

identifying information reading means connected to external storing means for reading out said user identification information from an external storage means connected to said terminal equipment, and conveying said user identification information to said network as part of said available environmental information.

15. (Previously Presented) The terminal equipment according to Claim 13 comprising:

identifying information receiving means for receiving the user identification information of said user transmitted from portable terminal means connected to

said terminal equipment, and transmitting said user identification information to said network as part of said available environmental information.